

Attorney's Docket No.: 004490.P001

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#3

In Re Patent Application of:

Sanjeev I. KRIPLANI, et al.

Examiner: Not Yet Assigned

Application No.: 09/714,898

Art Unit: 2161

Filed: November 15, 2000

For: SYSTEM AND METHOD FOR
INVOICE CONFIRMATION AND
FUNDING

RECEIVED

SEP 20 2001

Group 2100

Assistant Commissioner for Patents
Washington, D.C. 20231
Attention: Special Program Examiner, Group 2161

PETITION TO MAKE SPECIAL FOR NEW APPLICATION
Under 37 C.F.R. § .102(d), MPEP § 708.02, VIII

Sirs:

A. Petition and Fee

The Applicants hereby petition to make this application special. This application has not received any examination by an Examiner.

The Applicants hereby enclose a check in the amount of \$130.00 for the petition fee required by 37 C.F.R. § 1.17(i). Furthermore, authorization is hereby granted to charge payment of any fees due under 37 C.F.R. § 1.16 and § 1.17

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to the Assistant Commissioner for Patents, Washington, D. C. 20231

on

September 13, 2001
(Date of Deposit)

Lindy Vapich
(Typed or printed name of person mailing correspondence)

(Signature of person mailing correspondence)

associated with this communication or any future communication in this or any related application filed pursuant to 37 C.F.R. § 1.53 or credit any overpayment to Deposit Account No. 02-2666.

B. Claims

Either (1) all pending claims in this application are directed to a single invention, or (2) if the Office determines that all the claims are not obviously directed to a single invention, the Applicants will make an election without traverse in response to notification under the established telephone restriction practice.

C. Pre-Examination Search

A prior art search relating to claims of corresponding PCT patent application PCT/US00/31898, which claims correspond substantially to the claims of the present application, has been completed. A copy of the relevant PCT International Search Report (ISR) is attached.

D. Copies of the References / Information Disclosure Statement

Copies of the references identified in the ISR, along with a copy of the ISR itself, are enclosed. These references were disclosed to the USPTO in an Information Disclosure Form PTO-1449 filed in the present application on April 23, 2001. The ISR report identifies three references, each of which is categorized as an "A" category document. Each of the following references is discussed below: US patent number 5,920,847 (hereinafter Kolling); US patent number 6,070,150 (hereinafter Remington); and US patent number 6,092,053 (hereinafter Boesch).

E. Detailed Discussion of the References

The Applicants submit the references identified in the ISR fail to anticipate any of the currently pending claims of the present application, as none of these references teaches every element of any of the independent claims. Specifically, the Applicants contend that each element of each of the independent claims is not either expressly or inherently described in any single one of the cited prior references.

The Applicants contend that the references identified in the ISR further fail to support a *prima facie* case of obviousness as these references, individually or in combination, neither teach nor suggest all of the claim limitations or elements of each of the independent claims. Further, there is no teaching or suggestion in these references themselves, or in knowledge generally available to one skilled in the art, to modify the references or to combine the references to support an obviousness rejection of any one of the independent claims of the current application.

Accordingly, the Applicants believe all pending claims to be allowable over the references cited in the ISR.

The above contentions of the Applicants are supported by the ISR itself, which categorizes each of the cited references as being in the "A" category of the PCT special categories of cited documents. This indicates that the PCT searcher considered all references as defining the general state of the art, but not to be of particular relevance.

The Applicants below provide a discussion of each of the references cited in the ISR, and point out how the claimed subject matter of the present application is patentable over these references.

Considering claim 1 of the present application as an exemplary claim, this claim reads as follow:

“A method for payment of an invoice evidencing a payment obligation of a payer to a biller using a third-party intermediary, comprising:

receiving at the intermediary a nonrepudiable commitment from the payer to pay an amount of an invoice that is directly authorized by the payer, wherein the commitment includes a payment date subsequent to such authorization;

receiving from the biller a legally binding commitment to pay the amount of the invoice that is directly authorized by the payer to the intermediary if the payer does not pay the amount of the invoice to the intermediary;

receiving at the intermediary directly from the payer an authorization to pay the amount of the invoice to the biller;

after directly receiving the authorization, paying to the biller at least a substantial portion of the amount of the invoice; and

subsequently collecting from the payer (or the payer's agent) the amount of the invoice.”

The Applicants will below deal with each of the references identified in the ISR.

1. US Patent number 5,920,847 (Kolling). Kolling discloses a bill payment system whereby a consumer is able to pay a bill to a participating biller thorough a payment network. To authorize a remittance the consumer transmits to a participating bank a bill pay order indicating, *inter alia*, a payment date, a

payment amount and source of funds. The bank then submits a payment message to a payment network which in turn forwards the payment message to the bank or biller. For settlement, the consumer's bank debits the consumer's account and is obligated to a net position with the payment network. The biller's bank receives a net position from the payment network, and credits the biller's bank account.

If the consumer's bank agrees to send non-reversible payment messages, the consumer's bank does not submit the transaction until funds are good, unless the consumer's bank is willing to take the risk of loss if funds are not good, in the case of a guaranteed payment network. (see Abstract).

Kolling provides no disclosure that can be considered anticipatory of a number of limitations of claim 1. For example, Kolling provides no disclosure of receiving, from a biller, a legally binding commitment to pay the amount of an invoice that is directly authorized by the payer to the intermediary, if the payer does not pay the amount of the invoice to the intermediary.

For this reason alone, the Applicants contend that each element of claim 1 is not expressly or inherently described in Kolling.

2. US Patent number 6,070,150 (Remington). Remington describes a bill presentment and payment remittance system used over an electronic network (e.g., the Internet). A biller creates and submits a bill electronic transmission over the network to the consumer. The consumer authenticates that the bill did indeed come from the indicated biller. The consumer controls the payment authorization, specifying the amount to be paid (either partial or full), and the date for the payment to be made, and the account from which the money will be drawn. Payment instruction and remittance information are transmitted in a biller prescribed format back over network to the biller. The biller executes the payment instructions sent to it electronically by the consumer by sending them onto the biller's bank. (See Abstract 1).

Again, the Applicants contend that Remington does not expressly or inherently describe each element of independent claim 1. For example, Remington, as with Kolling, makes no mention of receiving, from a biller, a legally binding commitment to pay the amount of an invoice that is directly authorized by the payer to the intermediary, if the payer does not pay the amount of the invoice to the intermediary.

For the above reason alone, each element of independent claim 1 is not expressly or inherently described in Remington.

3. US Patent number 6,092,053 (Boesch). Boesch discusses a system for merchant invoked electronic commerce. The system includes a server having software that gathers purchasing information for a consumer to complete a purchasing transaction over a network. The system has a consumer data structure that stores purchasing information for registered consumers. This data structure can be accessed for the purposes of entering the consumer's purchasing information during subsequent purchases. Thus, the consumer does not have to enter the same information every time they purchase an item over the network.

Clearly each element of independent claim 1 is not expressly or inherently described in Boesch. For example, Boesch fails to provide any disclosure that may be considered to be anticipatory of receiving, from a biller, a legally binding commitment to pay the amount of an invoice that is directly authorized by the payer to the intermediary, if the payer does not pay the amount of the invoice to the intermediary.

Summary

The Applicants contend that the references identified in the ISR fail to support a novelty rejection against independent claim 1, as none of these references teach each element (e.g., the limitation of receiving from the biller a legally binding commitment) of independent claim 1.

The Applicants further contend that the references identified in the ISR fail to support an obviousness rejection against claim 1 for at least the reason that the references, individually or in combination, neither teach nor suggest all the claim limitations or elements (e.g., the limitation of receiving from the biller a legally binding commitment) of independent claim 1.

The Applicants respectfully submit that claim 1 is thus allowable as being both novel and non-obvious in light of the references cited in the ISR.

The above comments and remarks are furthermore applicable to a consideration of the allowability of independent claim 12 of the present application, which includes limitations corresponding substantially to those of claims 1. Accordingly, the Examiner is requested to consider the above remarks when examining independent claim 12 for allowability.

The Applicants consider all claims of the present application to be in a condition for allowance, which is earnestly solicited.

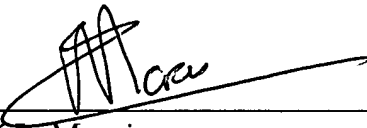
If, in the opinion of the Examiner, a telephone conference would in any way assist to expedite the allowance of the present application, the Examiner is invited to call the undersigned attorney at (408) 947-8200 ext. 204.

Authorization is hereby given to charge our account no. 02-2666 for any charges that may be due.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 09/13/2001



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09/21/01

FEE TRANSMITTAL FOR FY 2001

TOTAL AMOUNT OF PAYMENT (\$) 130.00

Complete if Known:

Application No. 09/714,898
Filing Date November 15, 2000
First Named Inventor Sanjeev I. KRIPLANI
Group Art Unit 2161
Examiner Name Not yet assigned
Attorney Docket No. 004490.P001

METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number 02-2666
Deposit Account Name _____

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

- ☐ Applicant claims small entity status. See 37 CFR 1.27

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Group 2100

2. ☒ Payment Enclosed: ☒ Check

Credit Card

Money Order

Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Code	Fee (\$)	Code	Fee (\$)		
101	710	201	355	Utility application filing fee	_____
106	320	206	160	Design application filing fee	_____
107	490	207	245	Plant filing fee	_____
108	710	208	355	Reissue filing fee	_____
114	150	214	75	Provisional application filing fee	_____

SUBTOTAL (1) \$ NA

2. EXTRA CLAIM FEES

		Extra Claims	Fee from below	Fee Paid
Total Claims	_____	- 20** = _____	X _____	= _____
Independent Claims	_____	- 3** = _____	X _____	= _____
Multiple Dependent	_____		_____	= _____

**Or number previously paid, if greater; For Reissues, see below.

Large Entity		Small Entity		Fee Description
Code	Fee (\$)	Code	Fee (\$)	
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

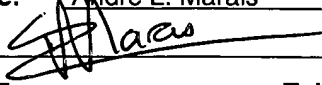
SUBTOTAL (2) \$ NA

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

<u>Large Entity</u>		<u>Small Entity</u>		<u>Fee Description</u>	<u>Fee Paid</u>
<u>Fee Code</u>	<u>Fee (\$)</u>	<u>Fee Code</u>	<u>Fee (\$)</u>		
105	130	205	65	Surcharge - late filing fee or oath	_____
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	_____
139	130	139	130	Non-English specification	_____
147	2,520	147	2,520	For filing a request for ex parte reexamination	_____
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	_____
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	_____
115	110	215	55	Extension for reply within first month	_____
116	390	216	195	Extension for reply within second month	_____
117	890	217	445	Extension for reply within third month	_____
118	1,390	218	695	Extension for reply within fourth month	_____
128	1,890	228	945	Extension for reply within fifth month	_____
119	310	219	155	Notice of Appeal	_____
120	310	220	155	Filing a brief in support of an appeal	_____
121	270	221	135	Request for oral hearing	_____
138	1,510	138	1,510	Petition to institute a public use proceeding	_____
140	110	240	55	Petition to revive - unavoidable	_____
141	1,240	241	620	Petition to revive - unintentional	_____
142	1,240	242	620	Utility issue fee (or reissue)	_____
143	440	243	220	Design issue fee	_____
144	600	244	300	Plant issue fee	_____
122	130	122	130	Petitions to the Commissioner	_____
123	50	123	50	Processing fee under 37 CFR 1.17(q)	_____
126	180	126	180	Submission of Information Disclosure Stmt	_____
581	40	581	40	Recording each patent assignment per property (times number of properties)	_____
146	710	246	355	For filing a submission after final rejection (see 37 CFR 1.129(a))	_____
149	710	249	355	For each additional invention to be examined (see 37 CFR 1.129(b))	_____
179	710	279	355	Request for Continued Examination (RCE)	_____
169	900	169	900	Request for expedited examination of a design application	_____
195	300	195	300	Publication fee for early, voluntary, or normal publication	_____
196	300	196	300	Publication fee for republication	_____
194	130	194	130	Request for voluntary publication or republication	_____
098	130	098	130	Processing fee under 37 CFR 1.17(i)	_____
091	1,240	091	1,240	Acceptance of unintentionally delayed claim for priority	_____
Other fee (specify) <u>Petition to Make Special</u>					<u>130.00</u>
Other fee (specify) _____					_____

SUBTOTAL (3) \$ 130.00

*Reduced by Basic Filing Fee Paid

SUBMITTED BY:Typed or Printed Name: André L. MaraisSignature:  Date: 09/13/01Reg. Number: 48,095 Telephone Number: (408) 947-8200**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.